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| DELBERT CLARKE PILE 430 NORTH SHORE ROAD HADLEY, NY 12835 | | | EXAMINER CHAMBERS, MICHAEL S | |
| | | | ART UNIT 3711 | PAPER NUMBER |

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,330

Applicant(s)

PILE, DELBERT CLARKE

Examiner

Mike Chambers

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 13. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-10, 13,15,18-19, 21-24, 27-30, 33,35, 40 ,41,43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape.

GarageScape discloses the elements of claim 1, however it fails to clearly disclose the use of a support arm for the basketball goal. The device of GarageScape would naturally have a support arm in order to keep the device above the ground. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed any one of several equivalent support structures based on cost and design considerations.

As to claims 2 and 22: GarageScape discloses a support member that deploys the backboard into an upright position (see pictures in GarageScape).

As to claims 3 and 23: GarageScape discloses a backboard that unfolds/folds to a use position (see pictures in GarageScape). The specification provides no detail as to what constitutes a "folded/unfolded position", therefore the device of GarageScape has a folded (inside) and unfolded (outside) position.

As to claims 4 and 24: GarageScape discloses a backboard that is moved to a second position (see pictures in GarageScape). The structure would naturally be capable of being rotated. In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112). Normal engineering techniques would naturally segment parts of the support structure and these would be capable of some rotation when being used.

As to claims 7 and 27: GarageScape discloses a support member that moves in a longitudinal and opposite direction (see pictures in GarageScape).

As to claims 8 and 28: GarageScape discloses a backboard that is deployed outside the structure (see pictures in GarageScape).

As to claims 9 and 29: The device of GarageScape would naturally have a mounting element in order to secure the device and permit it to operate (see pictures in GarageScape).

As to claims 10 and 30: GarageScape discloses a dedicated structure (see pictures in GarageScape).

As to claims 13, 19, 33 and 41: GarageScape discloses a mechanical device for deploying the backboard (see pictures in GarageScape).

As to claim 15 and 35: GarageScape discloses an unfoldable backboard (see pictures in GarageScape). The size of the opening would naturally indicate the backboard was "unfoldable".

As to claims 18, 40 and 43: GarageScape discloses an in-use and non-use position (see pictures in GarageScape).

As to claim 21: See claim 1 rejection. The device GarageScape discloses an in-use and non-use position (see

As to claim 45: See claim 21 rejection. The device GarageScape discloses a stored position (see pictures in GarageScape).

Claims 5, 12, 16, 17, 32, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape as applied to claim 1 and further in view of Official Notice. Official Notice is taken that the use of motors is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a motor with the apparatus in order easily use the device.

As to claims 12, 16, and 32 : See claim 5 rejection. GarageScape discloses moving a backboard to an in-use a dedicated structure (see pictures in GarageScape).

As to claims 17, and 38 : See claim 5 rejection. GarageScape discloses moving a backboard to an in-use a dedicated structure (see pictures in GarageScape). The device would naturally also be used to return the device to a non-use position.

Claims 14, and 34, are rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape as applied to claim 1 or claim 21 and further in view of Official Notice. Official Notice is taken that the use metal and other materials is well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected an appropriate material based on cost and design considerations.

As to claim 25: See claim 5 rejection. GarageScape discloses moving a backboard to a non-use position (It is well known in the art to have positioning devices automatically extend for use and retract.)

Claims 11 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape as applied to claim 1 and further in view of Lancellotti (3716234). Lancellotti discloses a foldable backboard (fig 6 and 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the foldable backboard of Lancellotti with the apparatus of GarageScape in order to provide a more compact apparatus for moving and storing the device.

As to claim 36: See claim 11 rejection.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape and Lancellotti as applied to claim 36 and further in view of Miller et al (3452984). In as much structure set forth in the claims, Miller discloses a "computer" (item 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the computer of Miller with the apparatus of GarageScape

in order to easily control the movement of the backboard from a use position to a non-use position.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape as applied to claim 38 and further in view of Miller et al (3452984). In as much structure set forth in the claims, Miller discloses a "computer" (item 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the computer of Miller with the apparatus of GarageScape in order to easily control the movement of the backboard from a use position to a non-use position.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape as applied to claim 41 and further in view of Miller et al (3452984). In as much structure set forth in the claims, Miller discloses a "computer" (item 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the computer of Miller with the apparatus of GarageScape in order to easily control the movement of the backboard from a use position to a non-use position.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over GarageScape as applied to claim 43 and further in view of Miller et al (3452984). In as much structure set forth in the claims, Miller discloses a "computer" (item 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the computer of Miller with the apparatus of GarageScape in order to easily control the movement of the backboard from a use position to a non-use position.

Claims 1, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackan (4934696). Jackan discloses a basketball backboard (10) and hoop assembly (34); a support arm for supporting the basketball backboard and hoop assembly; and a support element (22,24,or 20). Although Jackan does not clearly disclose the movement of the backboard, the backboard would naturally move longitudinally or in a rotation when the door was opened or closed. In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 21 : See claim 1 rejection.

Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackan as applied to claims 1 or 21 and further in view of Official Notice. Official Notice is taken that the use of garage door openers is well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a garage door opener with the apparatus in order easily raise and lower the door

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,736,741. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are simply broader than the patent claims and clearly "read" on the claims in the patent.

Claims 1-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,508,730. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are simply broader than the patent claims and clearly "read" on the claims in the patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4934696*3452984*3716234*6508730*6736741*

Michael Chambers
Examiner
Art Unit 3711

July 15, 2005


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